

REMARKS

Reconsideration of the application is respectfully requested on the grounds that U.S. Patent No. 6,636,247 (Hamzy), relied upon to show the concept of blocking access to a website requested by a user, as claimed, is not “prior art,” and on the grounds that the Applicant has shown conception prior to the January 31, 2007, filing date of the Hamzy patent and diligence between January 31, 2007 filing date and the filing date of the present application, December 22, 2007.

A previous declaration to show diligence was considered to be ineffective to overcome the rejection because the Examiner considered there to be “gaps” in the demonstrated diligence. An interview with the Examiner revealed that the “gaps” related to the Examiner’s perception of the evidence of classes attended, *i.e.*, that the Examiner considered the syllabi of the classes to evidence work on a different invention or project, which would not be a permissible excuse, rather than evidence of excusable activities necessary to make a living. In addition, the Examiner stated that he considered 11 months to be a long time to show diligence.

In reply, the Applicant respectfully submits the attached Second Declaration to Show Diligence, which again shows that he worked on development of his invention and its constructive reduction to practice every day during the eleven month period, except for short vacations, periods of illness, and moving from France to Greece after school ended. As explained in the Second Declaration, the evidence of classes was intended to show why the constructive reduction to practice took eleven months—namely because the Applicant was a graduate student with a heavy class load while at the same time working on development of his invention and filing of a patent application. In fact, considering that the Applicant conceived of the invention while a graduate student with several months to go before graduation, in a foreign country with no prior knowledge of U.S. intellectual property law,

the fact that he was able to go from conception to filing of a patent application in less than a year is evidence of extraordinary diligence, rather than lack of diligence.

The flowchart attached to the previously submitted declaration, a copy of which is also attached hereto, shows continual development of the invention despite the requirement of graduate school. Every day is accounted for. There are no unexplained periods of inactivity. Instead, there is a period of about five months when the Applicant was taking a heavy course load (required by the school) and still working on the invention, and a period of less than six months during which the Applicant continued to develop his invention and at the same time contacted a Greek-speaking general practice attorney in the U.S., and ultimately a U.S. patent attorney.

The court cases emphasize that the “**reasonable everyday problems and limitations encountered by the inventor**” need to be considered in evaluating “diligence” (*Griffith v. Danamaru*, 2 USPQ 2d 1361 (Fed. Cir. 1987). MPEP 2138.06 gives little guidance about what constitutes acceptable excuses, but does cite the case of *De Solms v. Schoenwald*, 15 USPQ2d 1507 (Bd Pat. App. & Inter. 1990) in which the Board of Patent Appeals and Interferences took into account the fact that the junior party in an interference were **graduate students** with relatively little skill and therefore took longer to reduce their invention to practice than the senior party. As explained in the *De Solms* case:

In contrast to the situation in Griffith, Schoenwald and Barfknecht had funding for their project throughout the diligence period, and it is clear from the testimony of Dixson and Eller that they were diligently working on the project *to the extent that their positions as graduate students allowed throughout the critical period*. It is a principle of diligence that consideration must be given to the circumstances of the inventor, including his skill and available time, and that the inventor may avail himself of the activities of others. (Rivise and Caesar, *Interference Law and Practice*, §§191, 198 (Michie Co. 1940). Accordingly, we find that the diligent activities on behalf of Schoenwald are not negated by the fact that Dixson and Eller did not possess the same level of skill as De Solms or that Dixson and Eller were not able to work full time on their project.

It is respectfully submitted that the skill of the Applicant, Leandros Kontogouris, or more precisely the lack of experience in filing patent applications in the U.S., as well as the circumstance that the Applicant was a graduate student during much of the diligence period in question, should likewise be taken into account in determining whether the Applicant was diligent. In fact, the Applicant's circumstances were considerably more difficult than those of the students in the *De Solms* case since the Applicant is a foreign national from a non-English speaking country, taking graduate courses in a field other than the field of his invention.

While eleven months is a long period to show diligence, such extended periods are not unprecedented. For example, *Poage v. Dyer*, 184 USPQ 223 (Bd Pat. App. & Inter. 1974) involved a ten month period, while *Rines v. Morgan*, 116 USPQ 145 (CCPA 1957) involved an eight month period. The circumstances in these cases were less difficult than the Applicant's since neither involved a foreign applicant attending graduate school full time.

Because the Applicant has shown reasonable diligence for the entire period between the effective date of the Hamzy patent and construction reduction of the invention to practice, and further has shown conception of the invention before the effective date of the Hamzy patent, it is respectfully submitted that the Hamzy patent is not prior art with respect to the claims of the present application.

Since the Hamzy patent is the *only* reference of record that discloses the concept of blocking access to a website requested by the user, which is positively claimed, it is respectfully submitted that removal of the Hamzy patent as a prior art reference overcomes the rejection. The Auxier patent not only "*does not explicitly disclose preventing access to said website, and continuing to prevent said access to said website so long as the user fails to submit the appropriate reply,*" it does not *implicitly* disclose, or even have anything to do with, such blocking. To the contrary, Auxier is directed to an interactive banner advertisement

Serial Number 09/742,438

that pops up when a user requests a website, and that sends the user to a third party website (*rather than the requested website*) when the user interacts with the advertisement. The user of Auxier's system is free to access the requested website by simply not responding to the advertisement, and therefore cannot possibly be said to be blocked by the advertisement in the manner claimed. The remaining patents applied in the Official Action, all of which have been discussed in previous responses, also do not even remotely suggest the claimed blocking. Only the Hamzy patent discloses the presently claimed blocking, and the Hamzy patent is not prior art with respect to the present application.

Having thus overcome each of the rejections made in the Official Action, expedited passage of the application to issue is requested.

Respectfully submitted,

BACON & THOMAS, PLLC



By: BENJAMIN E. URCIA
Registration No. 33,805

Date: October 31, 2007

BACON & THOMAS, PLLC
625 Slaters Lane, 4th Floor
Alexandria, Virginia 22314

Telephone: (703) 683-0500

NWBS:\Producer\beu\Pending 1...PK\KONTOOOURIS742438a06.wpd